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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/847,942

Applicant(s)

JOSEPH ET AL.

Examiner

Carrie S Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 26-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20, 22-25 and 40-49, drawn to pressure sensitive adhesive fibers, a nonwoven web, a stretch removable article and a medical article, classified in class 428, subclass 297.4.
  - II. Claim 21, drawn to a method for making a minimicrofibrous reinforced adhesive fiber, classified in class 427, subclass 207.1.
  - III. Claims 26-35, drawn to a substrate, classified in class 57, subclass 260.
  - IV. Claims 36-39, drawn to a tape, classified in class 422, subclass 149.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a continuous spinning process can make pressure sensitive adhesive fibers.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the substrate does not require pressure sensitive fibers. The subcombination has separate utility such as gauze.

Inventions I and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive blend and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a

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nasal fibrillator can be made from forming a molten mixture comprising a pressure sensitive adhesive with a reinforcing material capable of forming minimicrofibers when subjected to shear force.

Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, a nasal fibrillator can be made from forming a molten mixture comprising a pressure sensitive adhesive with a reinforcing material capable of forming minimicrofibers when subjected to shear force.

Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a tape does not require a substrate. The subcombination has separate utility such as gauze.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ann M. Mueting on 7/17/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20, 22-25 and 40-49.

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Applicant in replying to this Office action must make affirmation of this election. Claims 21 and 26-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

6. Claim 14 has an improper Markush group. The examiner suggests adding the phrase "the group consisting of" after the phrase "selected from".

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

8. Claims 1-20, 22-25 and 40-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "at least about" in claims 1,3,4,17, 19 and 20 is a relative phrase that renders the claim indefinite. The phrase "at least about" is not defined by the claims, the specification does

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not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what is the maximum load; yield point and elongation break of the pressure sensitive adhesive fibers.

The phrase "no greater than about" in claims 5,7 and 20 is a relative phrase that renders the claims indefinite. The phrase "no greater than about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what is the yield point, diameter and yield strength of the pressure sensitive adhesive fiber.

Claim 2 is rendered indefinite because of the term "substantially". It is unclear as to whether or not the minimicrofibrous organic polymeric reinforcing material contains only continuous minimicrofibers.

Claim 8 is indefinite because of the phrase "greater than about". It is unclear as to what is the aspect ratio of the minimicrofiber.

Claim 13 is indefinite because of the phrase "at least about". The claim does not distinctly point out that the glass transition temperature is 10°C.

Claim 15 is indefinite because of the phrase "greater than about". Claim 15 does not distinctly point out that the yield strength of the elastomer is 20MPa.

*Claim Rejections - 35 USC § 102*

9., The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-20, 22-25 and 40-45 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Riedel et al., U.S. Patent Number 6,133,173.

The Riedel reference discloses a nonwoven cohesive wrap that can be used as a protective underwrap, medical tape or athletic tape which comprises pressure-sensitive adhesive fibers and a non-pressure sensitive material that comprises conjugate fibers of different polymers or blends as per instant claims 1, 17, 20, 22-23, 25, 40-41, 43-45, 47 and 49(see abstract, column 1, lines 32-column 2, line 68 and column 3, lines 1-8). Riedel also discloses that the nonwoven wrap has a basis weight from 40 to 200 g/m<sup>2</sup>, an elongation break from 100 to 900 percent, tensile strength of at least 40 –260 grams/cm and at least 150% of the load at yield point as per instant claims 1, 3-5, 15, 17, 19-20, 22-23, 25, 40-41, 43 and 48 (see column 2, lines 24-25; claims 1,2 and 9-14



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and Table 1, column 14). The reference also discloses that the polymeric conjugate fibers are substantially continuous microfibers that have a diameter generally less than 25 microns as per instant claims 1, 2 and 7 (see column 2, lines 48-50 and column 3, lines 16-19). The non-pressure-sensitive adhesive material in fibrous form is disclosed in the reference as comprising 5 to 95 percent of the basis weight of the fibers as per instant claim 6 (see column 9, lines 26-52). Riedel discloses using suitable pressure-sensitive adhesives that include polyalphaolefin, rubber resin adhesives and acrylate adhesives wherein the acrylate polymer is crosslinked and comprises copolymerized monomers comprising at least one monofunctional free-radically copolymer reinforcing monomer having a homopolymer glass transition temperature higher than that of the alkyl (methyl)acrylate monomer as per instant claims 9-11, 13-14, 19, 24 and 42 (see column 4, lines 35-38; column 5, lines 31-55 and column 6, lines 16- column 7, line 26). A vinyl group such as styrene is disclosed in the reference as a suitable crosslinking agent as per instant claim 12 (see column 7, lines 35-54). The Riedel reference discloses that the non pressure-sensitive adhesive fibrous material comprises an elastomer and has a force of about 7.5-10 Mpa as per instant claims 15 and 20 (see column 9, lines 53-column 10, line 3). Suitable non-adhesive materials for use in forming conjugate fibers, for use in blends with the pressure-sensitive adhesive or for use as separate fibers are disclosed in the Riedel reference and include elastomeric materials that include metallocene-type polyethylene copolymers as per instant claim 17 (see column 8, lines 67-column 9, line 25). The conjugate microfibers can be present in the form of two or more layered fibers, sheath-core fiber arrangement or "island in the sea" type fiber structures as per instant claim 18 (see column 3, lines 3-8). The microfibers of Riedel meet

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the applicant's definition of minimicrofibers as being microfibers made out of more than one fiber.

10. Claims 1 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks, Jr. U.S. Patent Number 4,659,923 in view of Riedel et al., U.S. Patent Number 6,133,173.

The Hicks reference discloses a medical sensor that uses fiber optics comprising of pressure-sensitive adhesive fibers as per instant claim 46 (see abstract, column 3, lines 10-12, column 7, lines 55-59 and column 8, lines 9-10). Hicks does not disclose the components of the pressure sensitive adhesive fibers as per instant claim 1. Riedel does teach a nonwoven cohesive wrap that can be used as a protective underwrap, medical tape or athletic tape which comprises pressure-sensitive adhesive fibers and a non-pressure sensitive material that comprises conjugate microfibers of different polymers or blends. The microfibers of Riedel meet the applicant's definition of minimicrofibers as being microfibers made out of more than one fiber.

It would have been obvious to use the pressure-sensitive adhesive fibers of the Riedel patent in order to obtain a medical device that allows for the core of the device to be subjected to lateral tension forces (see Hicks, Jr. column 8, lines 16-17).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read "Cynthia H. Kelly", written in a cursive style.